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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,040	02/05/2001	Gary A. Sigel	A148 1330	8701

7590 12/16/2002

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EXAMINER
NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 12/16/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS=7

Office Action Summary	Applicati n No.	Applicant(s)	
	09/777,040	SIGEL ET AL.	
	Examin r	Art Unit	
	Kimberly T. Nguyen	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22 and 38-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22 and 38-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

This action is in response to the amendment submitted on October 3, 2002. It is acknowledged that claims 23-37 and 46-54 are cancelled and that claims 1-22 and 38-45 are elected.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Due to Applicant's remarks and amendments, the previous rejections of claims 1, 6, 12, 15, 19, 20, 38, and 43 under 35 USC 112, 2nd paragraph are withdrawn.

The term "approximately" in the phrase "cured to approximately the same extent" in claims 1 and 9 is a relative term which renders the claim indefinite. The term "approximately" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

Claims 1-22, 38-40, and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidle et al., U.S. Pat. No. 4,491,616 as previously stated in the Office Action submitted on June 5, 2002.

Schmidle shows a pigmented ink printing layer applied to the top of the base layer and is in register with the base layer (claim 4 and column 2, lines 1-10).

As to the newly added limitation which shows that "the first and second regions have been cured to approximately the same extent" in claims 1 and 9, the phrase introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113.* Further, process limitations are given no patentable weight in product claims.

Claim Rejections - 35 USC § 103

Claims 21 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidle et al., U.S. Pat. No. 4,491,616 in view of Sigel et al., U.S. Pat. No. 6,333,076 B1 as previously stated in the Office Action submitted on June 5, 2002.

Response to Arguments

Applicants' argument filed October 3, 2002 have been fully considered but they are not persuasive.

On pages 4-5, Applicant argues that the instant invention is different from the invention of Schmidle because the surface coverings or surface covering components of instant claims 1-8 include a curable component that is crosslinked to approximately the same extent, but by a different free radical polymerizable mechanism or polymerization rate, in different regions on the top coat layer while Schmidle cures by using two completely different materials by two different curing mechanisms. This argument is not persuasive because such limitations as to the methods of curing by different methods and mechanisms are process limitations. The patentability of a product does not depend on its method of production. If the product in the

product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113.* Further, process limitations are given no patentable weight in product claims.

On page 5, Applicant argues that another way of distinguishing the instant invention from Schmidle's composition is that the instant invention includes a thermoset top coat layer while Schmidle's comprises primarily thermoplastic. This argument is also not persuasive because even if Schmidle shows a thermoplastic top coat and the instant invention shows a thermoset top coat layer, Applicant does not claim this limitation anywhere in the claims.

On pages 5-6, Applicants argue that the product-by-process claims 9-22 novel in view of Scmidle's compositions because Schmidle shows that its UV-curable component is only cured by one mechanism while the free-radical polymerizable components are cured to two different mechanisms. These are also process limitations. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113.* Further, process limitations are given no patentable weight in product claims.

On page 6, Applicant argues that Schmidle does not disclose nor suggest the presence of two regions with different gloss levels with approximately the same degree of crosslinking. Examiner is not persuaded because Shcmidle does show regions with different gloss levels (Abstract) and that such regions are cross-linked (column 2, lines 11-29). Further, Applicant does not specifically claim that the first and second regions comprise the same degree of crosslinking.

On page 6, Applicant argues that Schmidle does not teach or suggest surface covering components as in instant claims 38-45, only completed surface coverings. Examiner is not persuaded because Shmidle shows a completed surface covering which *includes* the surface covering component comprising the elements of the film, patterned layer, and top coat as in instant claim 38 (claim 1 and Abstract).

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

H. KELLY
PAT EXAMINER
TECH CENTER 1700

Cynthia Kelly